



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,183	01/23/2001	Jeno Gyuris	GPCI-P03-109	1943

28120 7590 09/24/2002

ROPES & GRAY  
ONE INTERNATIONAL PLACE  
BOSTON, MA 02110-2624

EXAMINER
----------

DAVIS, NATALIE A

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 09/24/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/768,183

Applicant(s)

GYURIS ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) 1-27, 34-53 and 90-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-32 and 54-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's response sent 5 July 2002 is acknowledged. Accordingly, claims 28-33 and 54- 88 are under examination.

2. Applicants point out that the previous Office Action indicates that claims 88-92 will be withdrawn from consideration and believes that claims 89-92 should be withdrawn. This is correct, claims 1-27, 34-53 and 89-92 are withdrawn from consideration.

#### *Response to Arguments*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Information Disclosure Statement*

4. The information disclosure statement has been considered. A signed copy is attached hereto.

#### *Specification Objection Maintained*

5. Objection to the disclosure is maintained because the amino acid sequences in the figures (fig. 5) have not been amended to include a sequence identifier. *fixed*

#### *Claim Rejections - 35 USC § 112 2<sup>nd</sup> Withdrawn*

6. Rejection of claims 86 and 88 under 35 U.S.C.112, second paragraph is withdrawn in view of explanation. However, the claims are objected to see below.

#### *New Claim Objections*

7. Claims 86 and 88 are objected to because the claims do not have sequence identifiers for the cysteine loop. Applicants indicate that figure 5 illustrates the sequence of mouse serum albumin around the Cys53-Cys62 loop and a skilled artisan would readily understand that Cys53-Cys62 stands for the cysteine loop of serum albumin starting from residue Cys53 to *withdrawn*

Art Unit: 1642

Cys62. However, all non-D amino acid sequences with four or more specifically defined amino acids must be referenced by sequence identifiers. Correction is required.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Maintained***

8. Rejection of claims 28-33 and 54-89 (paragraphs 12-15) under 35 U.S.C.112, first paragraph is maintained for reasons set forth in the previous office action. The traversal is on the grounds that serum albumin serves as a protein carrier and any nucleic acid encoding a peptide sequence published in literature to have activity may be used in the invention. There is no specific requirement for a particular biological activity, as long as the heterologous peptide has at least one biological activity. Applicant's arguments have been considered but are not persuasive because the specification (page 10) states that the heterologous peptide sequence shares less than 40% identity with a sequence to which it is compared. The claims are drafted do not indicate what sequence the heterologous peptide insert is to be compared to; thus, one of ordinary skill in the art would not know which heterologous peptide insert to select for to use in the invention as claimed.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Withdrawn***

9. Rejection of claims 28-33 and 54-89 (paragraphs 16-17) under 35 U.S.C.112, first paragraph is withdrawn in view of arguments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Application/Control Number: 09/768,183

Page 4

Art Unit: 1642

Natalie A. Davis, PhD  
September 23, 2002

  
SHEELA HUFF  
PRIMARY EXAMINER